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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/691,368	10/18/2000	Henry S. Marek	15-XD-5475	3507

7590

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EXAMINER

FLORES SANCHEZ, OMAR

ART UNIT

PAPER NUMBER

3724

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/691,368

Applicant(s)

MAREK ET AL.

Examiner

Omar Flores-Sánchez

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,4 and 8-28 is/are pending in the application.
- 4a) Of the above claim(s) 8-16 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 27 and 28 is/are allowed.
- 6) ☒ Claim(s) 1,3,4 and 17-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This action is in response to applicant's remarks received on 11/15/04.

#### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Bareggi (6234051 B1).

Bareggi discloses (Fig. 1-6) the invention including a handle 10, a slotted plate 20” having upper and lower panels, a recess (see Fig. 1) and a force gauge (see Fig. 6 and col. 3, lines 48-61).

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bareggi (6234051 B1) in view of Kolycheck (5,574,104).

Bareggi discloses the invention substantially as claimed except for an electrostatic dissipative material. However, Kolycheck teaches the use of an electrostatic dissipative material for the purpose of controlling static charge buildup and dissipation. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Bareggi's device by providing the an electrostatic dissipative material as taught by Kolycheck in order to obtain a total assembly environment to be constructed of partially conductive materials to control static charge buildup and dissipation.

6. Claims 18, 20 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cox et al. (4,403,533) in view of Kolycheck (5,574,104) and Wilhite (6,050,167).

Cox discloses (Fig. 1-8) the invention substantially as claimed including a stage (36 or 138) having a plurality of channels (38 or 142), a gas/air (where air is mostly nitrogen) and a vacuum 146. Cox doesn't show an electrostatic dissipative material. However, Kolycheck teaches the use of an electrostatic dissipative material for the purpose of controlling static charge buildup and dissipation. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Cox's upper surface of the stage by providing the electrostatic dissipative material as taught by Kolycheck in order to obtain a total assembly environment to be constructed of partially conductive materials to control static charge buildup and dissipation.

Regarding locating pins, Wilhite teaches the use of pins 1d for the purpose of locating the

Art Unit: 3724

work at a desired distance. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Cox's device by providing pins as taught by Wilhite in order to obtain a better accurate device to locate the work piece.

7. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cox et al. (4,403,533) in view of Kolycheck (5,574,104) and Wilhite (6,050,167) as applied to claim 18 above, and further in view of Turner (5,820,006).

Cox discloses (Fig. 1-8) the invention substantially as claimed except for a turntable. However, Turner teaches the use of a turntable 32 for the purpose of rotating to the desired position. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Cox's device by providing a stage having channels as taught by Turner in order to obtain a device to rotate the panel to the desired position.

8. Claims 21-24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cox et al. (4,403,533) in view of Kolycheck (5,574,104) and Wilhite (6,050,167) as applied to claim 18 above, and further in view of Bareggi (6234051 B1).

The modified device of Cox discloses (Fig. 1-8) the invention substantially as claimed except for a separating device having a handle, a slotted plate having upper and lower panels, and a recess. However, Bareggi teaches the use of separating device having a handle 10, a slotted plate 20" having upper and lower panels, a recess (Fig. 1) and a force gauge (see Fig. 6 and col. 3, lines 48-61) for the purpose of permitting accurate control force applied to the workpiece. It would have been obvious to one having ordinary skill in the art at the time the

Art Unit: 3724

invention was made to have modified Cox's device by providing the separating device as taught by Bareggi in order to obtain a device to permits accurate control force applied to the workpiece.

Regarding the electrostatic dissipative material disposed in the slotted plate, Kolycheck teaches the use of the electrostatic dissipative material for the purpose of controlling static charge buildup and dissipation. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Bareggi 's separating device by providing the electrostatic dissipative material as taught by Kolycheck in order to obtain a total assembly environment to be constructed of partially conductive materials to control static charge buildup and dissipation.

***Allowable Subject Matter***

9. Claims 27 and 28 are allowed.

***Response to Arguments***

10. Applicant's arguments have been fully considered but they are not persuasive.

In response to applicant's argument that Bareggi does not show a slotted plate defining a recess of approximately the same width and thickness as the glass panel to be separated, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA

Art Unit: 3724

1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this instant case, Bareggi's slotted plate recess can engage a glass panel of the same dimension.

Applicant argues that Bareggi does not show a force applied by operator's hand to the handle in a linear manner. However, Bareggi teaches the force applied to the handle in a linear manner.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine Kolycheck can be found in col.1, lines 46-52). Also, applicant argues that the references do not teach "a vacuum configured to hold the glass panel tightly". However, Cox teaches a vacuum 146 configured to hold the glass panel tightly. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., pumping *pure* nitrogen) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant argues that is confused by this statement, however, in applicant's remarks received on 08/06/04, page 14, line 13, the term *pure* nitrogen was introduced as an argument, but there is no *pure* nitrogen cited in the claims.

***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Omar Flores-Sánchez whose telephone number is 571-272-4507. The examiner can normally be reached on 8:00-5:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 571-272-4514. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



Art Unit: 3724

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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